

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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EX PARTE HICKMAN *et al.*

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Application for Patent  
FOR  
AUTOMATIC ELECTRONIC DOCUMENT FILING SYSTEM, METHOD, AND  
ARTICLE OF MANUFACTURE

Serial No. 09/625,300

Filed 07/24/2000

Examined by KYLE R. STORK Art Unit 2178

REPLY BRIEF

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service at first class mail, postage prepaid, in an envelope addressed to: Box Appeal, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 12, 2012.

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Paul L. Hickman

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I. STATUS OF THE CLAIMS

Claims 1, 14-17, 21-32 and 36 are pending in this application.

Claims 21-30 are withdrawn from consideration.

Claims 1, 14-17, 31, 32 and 36 are rejected and are the subject of this appeal.

## II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The rejection of claim 36 under 35 U.S.C. 102(e) as being anticipated by Takano et al., U.S. Patent No. 6,434,580 ("*Takano*")
- B. The rejection of claims 1 and 14-17 under 35 U.S.C. 103(a) as being unpatentable over *Takano* and further in view of Brown et al., U.S. Patent No. 6,671,805 ("*Brown*")
- C. The rejection of claims 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over *Takano* and further in view of Daleen et al., U.S. Patent No. 6,493,722 ("*Daleen*")

### III. ARGUMENTS

- A. The rejection of claim 36 under 35 U.S.C. 102(e) as being anticipated by Takano et al., U.S. Patent No. 6,434,580 ("*Takano*") is in error and should be reversed

The Examiner argues that since, in certain embodiments, the client computer and the applicant computer can be on the same machine (*i.e.* they are "virtual machines") and that the intermediary server and the recipient server can be on the same machine (*i.e.* that they also can be "virtual machines"), that only two computers are disclosed. However, this is not the case. There is no distinction between a virtual machine and a "real" machine, and Applicant's claim still calls for a particular arrangement of four computers, while *Takano* only contemplates arrangements of two or three computers. More particularly, as noted previously *Takano* teaches a system whereby a patent application is prepared, on-line (*e.g.* over the Internet), for a client (*e.g.* patent applicant). After the application is prepared, it is downloaded to the client's computer. After verification by the client/applicant, it is transmitted to the USPTO. Therefore, *Takano* teaches a conventional network where one computer speaks directly to another, without the intermediaries of Appellant's claimed embodiment.

To decide otherwise is to read limitations out of Applicant's claim. First, even if the client computer and the applicant computer are virtual machines on a single hardware computer, the Examiner must show a single computer having two such virtual machines in order to meet the first two limitations of claim 36. Furthermore, even if the intermediary server and the recipient server are virtual machines on a single hardware server, the Examiner must show a single server having two such virtual machines interacting with the client computer and the applicant computer as recited in the claim.

In summary, even if the Examiner uses "broadest reasonable interpretation" to reduce the number of physical computers recited in claim 36, he still must show that *Takano* has the four computers (client computer, applicant computer, intermediary server and recipient server), either real or virtual, arranged as claimed in order to sustain a rejection under 35 U.S.C. 102(e). The Examiner has failed to do so.

The Examiner again relies on Fig. 15 of *Takano* to support his rejection. As seen below, *Takano* does not make use of a system of four computers (real or virtual) where the

communication is chained (applicant computer – client computer – intermediary computer – recipient computer) as set forth in the claim. Instead, with *Takano*, the client computer downloads a patent application from a first server and then transmits it to the USPTO. This is clearly does not meet the limitations of claim 36.

The Examiner argues that Takano's "Figure 15, item 100" can correspond to an "applicant computer", that Takano's "Fig. 15, item 200" can correspond to a "client computer", and that Takano's "Figure 15, item 300" can correspond to an "intermediary server." However, this is not the case. With Takano, item 300 would correspond to the "receiving agency computer" not an "intermediary server" and items 100 and 200 communicated directly with item 300. See, for example, Takano Fig. 15, column 15, line 37 – column 17, line 33.

Therefore, *Takano* does not teach the elements of an applicant computer – client computer – intermediary computer – recipient computer arranged such they communicate in a chained manner. Furthermore, *Takano* does not teach the limitation that the recipient computer communicates with the intermediary server as if it were communicating directly with the applicant computer (i.e. the "recipient computer" – e.g. the Patent Office 300 -- communicates directly with the "applicant computer" -- e.g. a patent applicant 100 -- in Takano). Appellant's intermediary computer is completely missing from Takano's disclosure. Therefore, *Takano* does not teach all of the elements of the claim and does not arrange the elements as recited in the claim. Appellants respectfully request that the rejection of claim 36 under 35 U.S.C. 102(e) be reversed.

- B. The rejection of claims 1 and 14-17 under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of *Brown* et al., U.S. Patent No. 6,671,805 ("*Brown*") is in error and should be reversed

As noted above, *Takano* is relied upon by the Examiner for the limitations of a web server, a receiving agency server and a client machine where the web server serves as a "middle-man" between the receiving agency computer and the client machine. That is, with Appellant's claimed inventions, the communication path is client machine – web server – receiving agency computer and vice versa. As noted previously, *Brown* does not cure this deficiency of *Takano*.

As noted previously, the claimed intermediary web server (which is entirely missing from the cited art) can provide authentication and encryption in its communications with both the client machine and the receiving agency computer. The web server also provides a form to the client machine and can fill in that form based upon information stored on the web server. The web server has a docketing function in that it automatically updates docketing information. Furthermore, the web server also transacts a financial transaction with the receiving agency server on behalf of the client. The fact that these functions can arguably be found in the prior art does not cure the fact that the combination of *Takano* and *Brown* do not disclose the combination of limitations recited in the claims. The rejection of claims 1 and 14-17 as being unpatentable over *Takano* in view of *Brown* was in error and should be reversed.

- C. The rejection of claims 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over *Takano* and further in view of *Daleen et al.*, U.S. Patent No. 6,493,722 ("*Daleen*") is in error and should be reversed

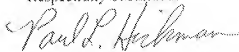
The Examiner repeats his errors, as set forth above, with respect to *Takano*. For example, *Takano* does not teach a web server that serves as an interface between a client machine and a receiving agency computer as recited in the claim. *Takano* also does not describe a web server interface which makes a payment on behalf of a client machine, nor a system where a receiving agency computer is communicating with a web server as if it were communicating directly with the client machine.

*Daleen* does not cure the deficiencies of *Takano* with respect to the missing elements. *Daleen* does not show a receiving agency server as asserted by the Examiner let alone an intermediary web server that serves as an interface to a receiving agency server. Furthermore, there is no description or suggestion in *Daleen* of an intermediate web server conducting a financial transaction with a receiving agency server on behalf of a client machine. *Daleen* also does not teach the automatic filling of electronic documents. For at least the foregoing reasons, the rejections of claims 31 and 32 as being unpatentable over *Takano* in view of *Daleen* is also in error and should be reversed.

#### IV. CONCLUSION

The rejections of claims 1, 14-17, 31, 32 and 36 were clearly in error for at least the reasons set forth above. Appellants respectfully request that the rejection of the claims be reversed.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Paul L. Hickman".

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